



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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MAILED

David E. Henn
Eugene Stephens & Associates
56 Windsor Street
Rochester, NY 14605

MAY 22 2003

**DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600**

Paper No. 7

In re application of
Aaron M. Sandlers
Application No. 09/640,196
Filed: August 16, 2000

: DECISION ON PETITION
: TO MAKE SPECIAL
: (PROSPECTIVE
MANUFACTURE)

For: BUSINESS METHOD AND
PROCESSING SYSTEM

This is a decision on the renewed petition under 37 C.F.R §1.102(d) filed May 02, 2003 to make the above-identified application special. The renewed petition requests that the above-identified application be made special under the procedure set forth in MPEP 708.02, item I: Prospective Manufacture.

The petition is **DENIED**.

MPEP 708.02 states that a Petition to Make Special based on Prospective Manufacture must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) the possession by the prospective manufacturer of sufficiently available capital (stating approximately the amount) and facilities (stating briefly the nature thereof) or that sufficiently available capital and facilities will be made available upon grant of a patent, with the proviso that if the prospective manufacturer is an individual a corroborating statement from a responsible party is required; (B) that the prospective manufacturer will not begin or increase production unless certain that the patent will be granted; (C) that the prospective manufacturer obligates themselves to manufacture the invention in the U.S. in quantity immediately upon the allowance of claims or issuance of a patent which will protect the investment of capital and facilities; and (D) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The decision mailed May 02, 2003 answering the petition filed September 30, 2002 states that the petition includes all of the requirements above except fully meeting items (A) and (C): "With regard to both items, a problem stems from the fact that the applicant is claiming a method or system of doing business. As such, there is nothing to "manufacture". One cannot be obligated to manufacture in the future, or state the nature of the facilities to manufacture, something that has no physical presence. Further with regard to item (A), the required statements as to the approximate amount of capital and the general nature of the facilities have not been included."

The renewed petition filed May 02, 2003 argues against the denial of the September 30, 2002 petition by stating that MPEP 708.02 (A) allows the petitioner to allege under oath or declaration that "sufficient capital and facilities will be made available if a patent is granted" instead of a statement as to the approximate amount of capital and the general nature of the facilities. The reason for denial of the petition under item (A) is in error and is hereby withdrawn.

The renewed petition filed May 02, 2003 attempts to remedy deficiencies based on the denial of the September 30, 2002 petition under MPEP 708.02 (C) by submitting a Supplemental Declaration by Applicant in order to prove that the construction/manufacture of the system involved in the patent application involves physical components and is extremely expensive, thereby meeting the "manufacturing" requirement under item (C). Applicant's declaration states that the patent application covers a 'system' that relates to manufacturing color prints on hard machinery placed inside buildings and would require high end printing machinery costing about \$250,000 for the machinery and \$50,000 for setting up the facility. However, nowhere in the claims in the pending patent application is there language requiring manufacturing color prints on hard machinery or any language pertaining to subject matter requiring of manufacturing.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above. Petitioner should promptly submit such a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.



Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

KJD/dxn : 5/19/03